

### **REMARKS**

The applicant has carefully considered the official action dated November 1, 2006. In view of the following remarks, the applicant respectfully traverses the rejections and submits that all pending claims are in condition for allowance. Accordingly, favorable reconsideration is respectfully requested.

### **The Rejections Under 35 U.S.C. §101**

Claims 1, 9, 19, and 25 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The applicant respectfully traverses these rejections.

A claim directed to a practical application constitutes statutory subject matter if it involves a physical transformation or if it is limited to a practical application that produces a useful, tangible, and concrete result, but in neither case preempts an abstract idea, a law of nature, or a natural phenomenon. *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

Independent claims 1, 9, 19, and 25 are directed to subject matter that involves a physical transformation. One example of a statutory process is where the process steps provide a transformation or reduction of an article to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 183 (U.S. 1981). Independent claims 1, 9, 19, and 25 of the pending application recite, *inter alia*, generating an instrumented code of the application, executing a plurality of tests on the instrumented code of the application, generating one or more test profiles associated with the plurality of tests, and identifying at least one test based on the test profiles. A test profile is the result of a physical transformation of test

code to a useful tool to improve debugging procedures. Specifically, test code, combined with instrumentation and an application, is converted to a test profile that may be prioritized, categorized, or otherwise manipulated. The test profiles may then be used to implement further machines, apparatus, and/or processes (e.g., identifying, or a device to identify, one or more tests).

Further, the processes, apparatus, and machines of claims 1, 9, 19, and 25 produce useful, tangible, and concrete results that do not preempt an abstract idea, a law of nature, or a natural phenomenon. In determining whether the claim is for a practical application, the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is useful, tangible and concrete. *AT&T Corp. v. Excel Communs., Inc.*, 172 F.3d 1352, 1361 (Fed. Cir. 1999). The identified test(s) of the present application is a useful, tangible, and concrete result that may be used, for example, to improve testing or debugging procedures. One of ordinary skill in the art would appreciate the large volume of tests that may be used to test or debug an application. Therefore, any process, machine, or apparatus that identifies efficient, practical, and/or preferred tests is certainly useful. The identification of the test enables a tester or programmer to utilize the most appropriate tests, thereby increasing efficiency and improving debugging capabilities.

Accordingly, the applicant respectfully submits that claims 1, 9, 19, and 25 are not directed to non-statutory subject matter under 35 U.S.C. § 101, and requests withdrawal of the §101 rejection of these claims and all claims dependent thereon.

**The Rejections Under 35 U.S.C. §102(b)**

Claims 1-6, 9-15, 18-22, and 24-29 have been rejected under 35 U.S.C. §102(b) as anticipated by Plum (U.S. Patent No. 5,758,061). The applicant respectfully traverses these rejections.

Independent claims 1, 9, 19, and 25 recite identifying, or a device to identify, at least one test based on at least one test profile. Despite the contention of the official action, no such operation is described in the cited art. Plum merely determines whether a path, when reached during testing, has been reached by previous tests. Further, the cited portions of Plum (col. 8, lines 9-11) describe a step to be performed during a test. Specifically, Plum describes creating an array of flags “indicating reached/unreached status for each path in the program” that is managed during a test. *See* col. 8, lines 9-24. As opposed to the post-test identifying operation of the pending application, the cited portion of Plum consists of a status check made while testing.

Moreover, in the present application, “identifying” involves an identification made among a plurality of tests. In other words, a choice or selection is made between multiple options. In one example, the identification is made from a list of tests. *See* pages 4-5, para. [0015]. In contrast, Plum involves a determination with only two options: reached or unreached. No identification (e.g., a choice or selection) is made in Plum. The system in Plum merely evaluates a condition and reaches a binary (e.g., yes or no) decision.

Accordingly, the applicant respectfully submits that claims 1, 9, 19, and 25 are not anticipated by Plum under 35 U.S.C. § 102(b), and requests withdrawal of the §102(b) rejection of these claims and all claims dependent thereon.

Dependent claims 3-5, 11-13, 21, 22, 27, and 28 recite generating, or a device to generate, a time stamp to correspond to a program state or breakpoint. No such operation is described in the cited art. The official action incorrectly contends that Plum describes generating such an operation by describing the addition of a current date and time to a results file to indicate when the test was run.

The time stamps of the present application are generated through the use of probes, which are placed in the code to detect program states (e.g.,  $x=y$ , a true condition, etc.). *See* pages 6-7, para. [0018]. When a probe indicates a particular program state or breakpoint has been reached a time stamp is generated to record the time at which it occurred. *Id.* For example, a time stamp may indicate the first time a particular program state is identified. *See* page 7, para. [0020]. Multiple time stamps are generated during a single test because as each program state or breakpoint is detected a new time stamp may be created.

The step cited in Plum (“an information line is written to the cumulative results file with the current date and time”) is triggered when the “first instrumented chunk [is] reached.” *See* col. 13, lines 41-52. Plum lists four steps, including the above cited step, that are “performed only once during execution of the instrumented program.” *See* col. 13, lines 43-44. In Plum, the current date and time are added to the results file to indicate when the application was run, not when a particular program state was reached. *See* col. 13, lines 50-51. The step cited above also includes adding the current user name and directory to the file. *Id.* This indicates that the current date and time are added for administrative purposes, rather than testing purposes.

Accordingly, the applicant submits that the claims 3-5, 11-13, 21, 22, 27, and 28 are not anticipated by Plum under 35 U.S.C. §102(b), and requests withdrawal of the §102(b) rejection of these claims.

Further, dependent claims 6, 14, 15, 24 and 29 recite generating, or a device to generate, a priority list of tests. The official action incorrectly contends that Plum describes such a priority list by citing the coverage reports. However, the coverage report of Plum consists of information regarding what “chunks” of code have been reached by the tests. *See* col. 6, lines 27-33. The coverage report does not prioritize results or tests in any manner. The results are merely combined into a file to indicate which sections of code were reached by each test. The file is used to aid testers in determining what sections of code have been tested and creating additional tests for unreached sections. *See* col. 6, lines 49-55.

In contrast, the priority lists of the present application are not based on the extent of application coverage. Rather, a priority list is a ranking of tests, based on test profiles, to aid in the identification of tests. *See* pages 4-5, para. [0015]. Generating a priority list includes, for example, arranging results in a manner to simplify a future decision or to clarify a set a results. No such arrangement or manipulation is described in Plum.

Accordingly, the applicant respectfully submits that claims 6, 14, 15, 24 and 29 are not anticipated by Plum under 35 U.S.C. § 102(b), and requests withdrawal of the §102(b) rejection of these claims.

**The Rejections Under 35 U.S.C. §103(a)**

Claims 7, 8, 16, 17, 23, and 30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Plum in view of Blasciak et al. (U.S. Patent Number 5,265,254).

Dependent claims 7, 16, 23, and 30, recite identifying, or a device to identify, at least one test based on the one or more test profiles in response to a query. The official action admits that Plum does not disclose such an operation. The applicant respectfully submits that the secondary reference, Blasciak, does not expressly or impliedly teach or suggest identifying at least one of a plurality of tests based on one or more test profiles in response to a query. Blasciak merely states that a database may be queried. The system in Blasciak includes a database of code markers used to instrument code. *See* col. 3, lines 54-55. During the process of inserting code markers into an application, the database is searched for the appropriate code marker for the current section of code. *See* col. 7, lines 38-43. In other words, the query in Blasciak is made to find a code marker within a database of instrumentation tools. This process in no way involves an identification or selection of a test based on a test profile.

Accordingly, because neither Plum nor Blasciak describes identifying at least one of the plurality of tests based on one or more test profiles in response to a query, no combination of these references can render claims 7, 16, 23, and 30 obvious under 35 U.S.C. §103(a). Thus, the applicant respectfully requests withdrawal of the §103(a) rejection of these claims.

In view of the foregoing, the applicant respectfully submits that all pending claims are in condition for allowance. Reconsideration of this application is respectfully requested. If there are any remaining matters that the examiner would like to discuss, the

examiner is invited to contact the undersigned representative at the telephone number set forth below.

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required during the pendency of this application to Deposit Account No. 50-2455.

Respectfully submitted,  
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